Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte STEPHEN MICHAEL REUNING

Appeal No. 2004-1714
Application No. 09/897,826

ON BRIEF

Before, HAIRSTON, KRASS and NAPPI, Administrative Patent Judges.
HAIRSTON, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 through 19.

The disclosed invention relates to a system and method for locating an individual with specifically defined professional qualifications via a search of a web page.

Claim 1 is illustrative of the claimed invention, and it reads as follows:

1. A system for locating an individual with specifically defined professional qualifications, the system comprising:

a. a filter that can search a web page to identify in said web page the presence or absence of specifically defined professional qualifications, and

b. an e-mail address extractor that can extract an e-mail address from said web page.

The reference relied on by the examiner is:

McGovern et al. (McGovern) 6,370,510 Apr. 9, 2002
(effective filing date May 8, 1997)

Claims 1 through 19 stand rejected under 35 U.S.C. § 102(e) as being anticipated by McGovern.

Reference is made to the supplemental brief and the reply brief (paper numbers 14 and 16, respectively) and the answer (paper number 15) for the respective positions of the appellant and the examiner.

OPINION

We have carefully considered the entire record before us, and we will sustain the anticipation rejection of claims 1 through 19.

The application before us on appeal is a continuation application of Application Number 08/984,650 filed December 3, 1997. In the parent application, appellant submitted an affidavit under 37 CFR § 1.131 to antedate the effective filing date of the same reference to McGovern. The examiner in the parent application

granted Appellant's affidavit request, and the parent application issued as U.S. Patent Number 6,381,592. Appellant has submitted the same affidavit in the subject application to antedate the McGovern reference. Appellant argues (supplemental brief, page 6; reply brief, pages 4 and 5) that the McGovern reference has already been antedated in the parent application, and that the Office should abide by the findings made in the parent application because "the pending claims are directed to the same subject matter."

Although the subject application and the parent application are directed to "the same subject matter," the claims on appeal differ from the claims allowed in the parent application. Accordingly, the examiner had both the right and the duty to take a fresh look at the affidavit based upon the claimed invention in the subject application. We find that the affidavit never specifically mentions the limitations of the claims before us on appeal. To be exact, the affidavit merely states that appellant conceived of a "system for searching for potential employment candidates" (paragraph 3), subscribed to an Internet service (paragraph 4), discussed the conception with some business associates (paragraph 5), learned how to write a patent application (paragraph 6), wrote a patent application, executed it and mailed it to the U.S. Patent Office before the end of November 1997 (paragraph 7), announced in

an internal company newsletter that the invention was reduced to practice in July 1997 on an Apple Macintosh operating system and computers (paragraph 8), and, after September 8, 1997, tested the system in a Windows environment (paragraph 9).

Based upon the noted contents of the affidavit, we agree with the examiner's findings (answer, page 6) that:

> [T]he conception is not correlated to the claims of the present application. In other words, while the affidavit does allege a specific date of conception, the subject matter which was conceived on the conception date cannot be correlated to the current claims on appeal. As [a] result, the affidavit under 37 CFR 1.131 is inconclusive in a determination of whether or not the claimed invention was conceived at [a] date prior to the effective filing date of McGovern et al. Since the affidavit is inconclusive in this particular analysis, it is not effective in overcoming the McGovern et al. reference.

In summary, the affidavit served to antedate the McGovern reference in the parent application, but it failed to do so in the present application.

Appellant's arguments (supplemental brief, pages 11 and 12; reply brief, pages 2 and 3) concerning estoppel and collateral estoppel are without merit in view of the fact that the claims and the issues before us in the subject application are not the same claims and issues that were presented in the parent application.

Turning to the prior art rejection, we agree with the examiner's findings (answer, pages 3 through 7) that the claimed invention reads directly on the teachings of McGovern. Although the job seekers in McGovern submit resumes to be placed in the database of computers 42, McGovern makes clear that they are converted to a HTML format (i.e., the software language used for creating World Wide Web pages) before they are placed in a position file database and posted on the web page run by the job search company 41 running the computer 42 (Figures 1 and 17; column 4, lines 4 through 37; column 17, lines 12 through 23). Appellant's arguments (reply brief, page 5) to the contrary notwithstanding, nothing in the claims on appeal precludes the job seekers from submitting resumes to be posted on the company's web page. The job seeker as well as the company can use the web page to locate employment opportunities. When the company uses the web page via the computer 42, a key word will be entered as a filter to search the web page to identify in the web page the presence of "specifically defined professional qualifications" in the resume database (column 18, lines 56 through 63), and the selected job seeker will be contacted via the e-mail address extracted from the same records posted on the web page (column 17, lines 12 through 23; column 18, lines 24 through 33). If the remote site 43 (Figure

1) is making a job search, then the same web page is searched to identify "specifically defined professional qualifications" in the position file database (column 4, lines 13 through 34), and the job seeker is notified of the results of the search via the e-mail address extracted from the records posted on the web page (column 4, lines 35 through 37). Thus, appellant's arguments (supplemental brief, pages 7 through 9; reply brief, pages 5 and 6) to the contrary notwithstanding, McGovern discloses both a "filter" and an "e-mail address extractor" as set forth in the claims on appeal.

In summary, the 35 U.S.C. § 102(e) rejection of claims 1 through 19 is sustained.

DECISION

The decision of the examiner rejecting claims 1 through 19 under 35 U.S.C. § 102(e) is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

KENNETH W. HAIRSTON)
Administrative Patent Judge)
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) BOARD OF PATENT
ERROL A. KRASS) APPEALS
Administrative Patent Judge) AND
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